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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,612	08/05/2000	Ronald John Rosenberger		2637

7590 08/26/2002  
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P O Box 286  
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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/364,612**

Applicant(s)  
**Rosenberger**

Examiner  
**James W. Myhre**

Art Unit  
**3622**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 1, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15, 17-19, 21-23, 27-29, and 31-59 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-6, 8-15, 17-19, 21-23, 27-29, and 31-59 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

***Response to Amendment***

1. The preliminary amendments filed on October 25, 2001 and May 1, 2002 have been received and entered. The currently pending claims are 1-6, 8-15, 17-19, 21-23, 27-29, and 31-59.

***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-6, drawn to cards and related services that use non-metallic symbolic colors to target specific demographic groups, classified in class 235, subclass 494.
  - II. Claims 8-11, drawn to a credit card entity having a plurality of cardholder names and signatures on the card, classified in class 235, subclass 380.
  - III. Claims 12-13, drawn to a credit card entity providing a reward for the apprehension of criminals associated with a crime against the cardholder, i.e. bodily harm insurance, classified in class 705, subclass 4.
  - IV. Claims 14-15, drawn to a credit card with customized messages printed thereon and selected by the cardholder, classified in class 705, subclass 14.
  - V. Claims 17-19, 21-23, 27-29, 31, 33-59, drawn to a method of a credit card entity providing special programs, messages, or services to the cardholder through the

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use of specialized messages or reminders printed on the cardholder's monthly credit card statement, classified in class 705, subclass 14.

- VI. Claim 32, drawn to a credit with a cash-back feature, i.e. rebate, payable annually, classified in class 705, subclass 14.

3. The inventions are distinct, each from the other because of the following reasons:

a. Inventions, Group I and Group II, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Group II has separate utility such as it can be used to provide a card that has a plurality of cardholder without providing a plurality of colors to personalize the card by incorporating a cardholder's preferred color of the card (MPEP § 806.05(d)).

b. Inventions, Group I and Group III, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group III has separate utility such as it can be used to provide rewards for the apprehension of criminals associated with a crime against the cardholder without providing a customized design or personalizing the card, such as providing a plurality of color to personalize the card by incorporating the cardholder's preferred color of the card (MPEP § 806.05(d)).

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c. Inventions, Group I and Group IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group IV has separate utility such as it can be used to provide specialized messages printed on the credit card without providing a plurality of colors to personalize the card by incorporating a cardholder's preferred color of card (MPEP § 806.05(d)).

d. Inventions, Group I and Group V, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group V has separate utility such as it can be used to provide personalized messages or reminders to a cardholder on the monthly credit card statement without providing a plurality of colors to personalize the card by incorporating a cardholder's preferred color of card (MPEP § 806.05(d)).

e. Inventions, Group I and Group VI, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group VI has separate utility such as it can be used to provide an annual cash-back rebate to the cardholder without providing a plurality of colors to personalize the card by incorporating a cardholder's preferred color of card (MPEP § 806.05(d)).

f. Inventions, Group II and Group III, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

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shown to be separately usable. In the instance case, Group III has separate utility such as it can be used to provide rewards for the apprehension of criminals associated with a crime against the cardholder without providing a plurality of cardholder names on the credit card (MPEP § 806.05(d)).

g. Inventions, Group II and Group IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group IV has separate utility such as it can be used to provide specialized messages on the credit card without providing a plurality of cardholder names on the credit card (MPEP § 806.05(d)).

h. Inventions, Group II and Group V, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group V has separate utility such as it can be used to provide personalized messages on the cardholder's monthly credit card statement without providing a plurality of cardholder names on the credit card (MPEP § 806.05(d)).

i. Inventions, Group II and Group VI, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group VI has separate utility such as it can be used to provide an annual cash-back rebate to the cardholder without providing a plurality of cardholder names on the credit card (MPEP § 806.05(d)).

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j. Inventions, Group III and Group IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group IV has separate utility such as it can be used to Group IV has separate utility such as it can be used to provide specialized messages on the credit card without providing rewards for the apprehension of criminals associated with a crime against the cardholder (MPEP § 806.05(d)).

k. Inventions, Group III and Group V, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group V has separate utility such as it can be used to provide personalized messages on the cardholder's monthly credit card statement without providing rewards for the apprehension of criminals associated with a crime against the cardholder (MPEP § 806.05(d)).

l. Inventions, Group III and Group VI, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group VI has separate utility such as it can be used to provide an annual cash-back rebate to cardholder without providing rewards for the apprehension of criminals associated with a crime against the cardholder (MPEP § 806.05(d)).

m. Inventions, Group IV and Group V, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group V has separate utility such as it can be

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used to provide personalized messages on the cardholder's monthly credit card statement without providing specialized messages on the credit card (MPEP § 806.05(d)).

n. Inventions, Group IV and Group VI, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group VI has separate utility such as it can be used to provide an annual cash-back rebate to cardholder without providing specialized messages on the credit card (MPEP § 806.05(d)).

o. Inventions, Group V and Group VI, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instance case, Group VI has separate utility such as it can be used to provide an annual cash-back rebate to the cardholder without providing personalized messages on the cardholder's monthly credit card statement (MPEP § 806.05(d)).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was not attempted because the requirement for restriction is complex. See MPEP § 812.01. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).




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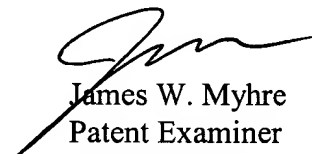
*Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM  
August 22, 2002

  
James W. Myhre  
Patent Examiner  
Art Unit 3622